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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,191	03/31/2004	Amit Bagga	503048-US-CIP (Bagga)	7508
47702	7590	04/25/2007	EXAMINER	
RYAN, MASON & LEWIS, LLP			GYORFI, THOMAS A	
1300 POST ROAD			ART UNIT	
SUITE 205			PAPER NUMBER	
FAIRFIELD, CT 06824			2135	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/815,191

Applicant(s)

BAGGA ET AL.

Examiner

Tom Gyorfi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☒ Claim(s) 6 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### DETAILED ACTION

1. Claims 1-27 are pending examination.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 15-16, 21-24, and 26-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-7, 9-10, 13, 17-19, 21-22, and 25 of copending Application No. 10/723,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to forming a password with low correlation to a user. The most pertinent correlation between the claims of the instant application to the copending application are: Instant claims 1, 21, and 27 to copending claims 1, 13, and 25 [forming a password with low correlative values]; and instant claims 2-4, 15-16, 22-24 to copending claims 5-7, 9-10, 17-19, and 21-22 [defining the low correlation between said password and said user].

### ***Claim Objections***

4. Applicant is advised that should claims 4 and 23 be found allowable, claims 6 and 24 will be respectively objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "qualitatively correlated" in claim 2 and "quantitatively correlated" in claim 3 are relative terms that render the claims indefinite. The aforementioned terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to an article of manufacture comprising a machine-readable medium containing one or more programs; this qualifies as software [descriptive material] *per se*, and is not recognized as statutory subject matter under current Office practice: *In re Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. Furthermore, as the article of manufacture does not appear to be defined as any type computer or machine capable of executing the claimed program

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(see the instant specification, page 21, lines 12-24), thus the claimed subject matter lacks any requisite functionality to satisfy the practical application requirement, again making the claim non-statutory: *Diamond v. Diehr*, 450 U.S. at 185-186, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”) See also MPEP § 2106.01.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanevsky et al. (U.S. Patent 5,774,525).

Regarding claims 1, 21, and 27:

Kanevsky discloses a method, apparatus, and article of manufacture for evaluating a password proposed by a user, comprising: receiving said proposed password from said user (col. 10, lines 17-31); and ensuring that a correlation between said user and said proposed password does not violate one or more predefined correlation rules (col. 10, lines 32-49). Per claim 21, Kanevsky further discloses a memory and processor (Figures 2-4).

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Regarding claims 2, 3, and 22:

Kanvesky further discloses wherein said one or more predefined correlation rules evaluate whether that said proposed password can be [qualitatively/quantitatively] correlated with said user (col. 10, lines 32-49).

Regarding claims 4, 6, 23, and 24:

Kanevsky further discloses wherein said proposed password is comprised of a proposed answer and a proposed hint and wherein said one or more predefined correlation rules evaluate whether said proposed answer can be obtained/correlated with said proposed hint in a particular relation (the question is itself a hint: col. 7, lines 33-64; cf. col. 8, lines 35-48).

Regarding claim 5:

Kanevsky further discloses wherein said particular relation is selected from the group consisting essentially of self, family member, co-author, teammate, colleague, neighbor, community member, or household member (col. 6, lines 10-30).

Regarding claims 7 and 25:

Kanevsky further discloses wherein said proposed password is an identifying number (e.g. col. 4, lines 25-30).

Regarding claims 8 and 26:

Kanevsky further discloses wherein one or more predefined correlation rules evaluate whether said identifying number identifies a person in a particular relationship to said user (col. 6, lines 10-30).

Regarding claim 9:

Kanevsky further discloses wherein said one or more predefined correlation rules evaluate whether said identifying number is a top N most commonly used identifying number (col. 6, lines 1-10).

Regarding claim 10:

Kanevsky further discloses wherein said one or more predefined correlation rules evaluate whether said identifying number is a top N commercial entity (Ibid, and also col. 9, lines 40-50).

Regarding claim 11:

Kanevsky further discloses wherein said one or more predefined correlation rules evaluate whether said identifying number identifies said user (inherent to a *personal identification number*. col. 4, lines 25-30).



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Regarding claim 12:

Kanevsky further discloses wherein said identifying number is a portion of a telephone number (a telephone number inherently being pertinent information when the invention is used to access the services of a "telephone provider": col. 9, lines 40-50).

Regarding claim 13:

Kanevsky further discloses wherein said identifying number is a portion of an address (col. 6, lines 25-30).

Regarding claim 14:

Kanevsky further discloses wherein said identifying number is a portion of a social security number (col. 6, lines 15-20).

Regarding claim 15:

Kanevsky further discloses where said proposed password is a word (noting that a password is distinct from a PIN: col. 4, lines 25-30).

Regarding claim 16:

Kanevsky further discloses wherein said one or more predefined correlation rules evaluate whether a correlation between said word and said user exceeds a predefined threshold (col. 9, lines 8-25).

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Regarding claim 17:

Kanevsky further discloses wherein said correlation is determined by performing a meta-search (col. 6, lines 47-59).

Regarding claim 18:

Kanevsky further discloses wherein said step of ensuring a correlation further comprises the step of performing a meta-search (col. 8, lines 9-34).

Regarding claim 19:

Kanevsky further discloses wherein said step of ensuring a correlation further comprises the step of performing a local proximity evaluation (col. 7, lines 50-60).

Regarding claim 20:

Kanevsky further discloses wherein said step of ensuring a correlation further comprises the step of performing a number classification (e.g. col. 7, lines 20-30).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication 2003/0154406 to Honarvar et al.
- U.S. Patent 6,954,862 to Serpa et al.
- U.S. Patent 6,845,453 to Scheidt et al.

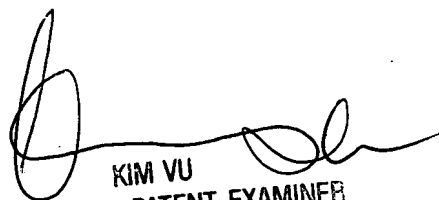
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG  
4/20/07

  
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